



21 MAR 2008

QUALCOMM INCORPORATED
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In re Application of	:	
BUTLIN et al.	:	
Serial No.: 10/598,163	:	DECISION ON
PCT No.: PCT/GB05/00627	:	
Int. Filing Date: 21 February 2005	:	SUBMISSION
Priority Date: 19 February 2004	:	
Attorney's Docket No.: 051038	:	
For: RENDERING A USER INTERFACE	:	

This is a decision on applicants' submission under 35 U.S.C. 371, filed on 01 November 2007 in the United States Patent and Trademark Office (USPTO). Applicant's request for a five month extension of time is granted.

BACKGROUND

On 02 April 2007, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 04 June 2007, in response to the Notification of Missing Requirements, applicant filed a declaration executed by three of the four joint inventors.

On 27 August 2007, a Notification of Defective Response was mailed to applicant indicating that declaration did not comply with 37 CFR 1.497(a) and (b) because "the fourth inventor was added without documentation". A new declaration was required. Applicant was given one month from the date of the Notification within which to reply or the time remaining in the Notification of Missing Requirements.

On 01 November 2007, applicant filed a new declaration, identifying the four joint inventors as listed on the international application.

DISCUSSION

The Notification of Defective Response incorrectly indicated the defect in the declaration was that "the fourth inventor was added without documentation". In fact, the fourth inventor identified in the international application was not listed on the executed declaration. Therefore

the Notification of Defective Response is hereby VACATED.

MPEP 201.03 states, in pertinent part, :

an oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

The declaration submitted on 01 November 2007 is a two page declaration. The declaration as submitted is comprised of three pages: one page marked "Page 1" and two pages marked "Page 2". The declaration appears to be a composite declaration created from the combination of separately executed declarations. The declaration is not properly executed. It appears that either the attorney pieced together separate complete declarations into one composite declaration or that the inventors were presented with an incomplete declaration. While it is acceptable for applicants to execute separate copies of the declaration, the entire declaration, as executed by the inventor, must be submitted. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." The declaration is unacceptable as filed and thus, the requirements of 37 CFR 1.497 (a) and (b) have not been met.

CONCLUSION

The 27 August 2007 Notification of Defective Response is hereby VACATED.

The application will be forwarded to the United States Designated/Elected Office for further processing, including reissuance of a Notification of Defective Response indicating that the declaration filed on 01 November 2007 is not compliance with 37 CFR 1.497(a) and (b) and is unacceptable for the reasons set forth above.



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